

REMARKS

In the Office Action mailed August 20, 2007, the Examiner rejected claims 32, 34-56. By way of the foregoing amendments and the markings to show changes, Applicants have amended claim 44. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Rejections under 35 USC 112

The Office Action rejected claim 44 under 35 USC 112 suggesting that the Examiner did not find support for a portion of that claim. Without acquiescing in this rejection, Applicants have deleted that portion of the claim.

II. Claim Rejections under 35 USC 103

The Office Action rejected claims 32, 34-39 and 41-43 as being unpatentable over a 1995 MY Chrysler JA publication (hereinafter simply referred to as Chrysler) in view of Admitted Prior Art (specification, Page 1), Ligon et al. (US 5,358,397), Hanley (US 5,266,133), Bryant (US 3,872,548), Johansson (EP 0398586 A1); Kracke (US 5013597); Ritzema (US 6024190); and Fitzgerald (US 2002/0074827). one or more of Wycech (US 6,270,600), Bryant et al. (US 3,872,548), Czaplicki (US 6,358,584), Czaplicki (US 6,263,635), Barz et al (US 6,467,834), Fitzgerald et al. (US 2002/0074827); and Jansen et al (US 5,591,386). Applicants traverse these rejections. Applicants have made several arguments as to the patentability of the claims of the present application and, since these arguments remain applicable, they are reasserted herein by reference. Further, Applicants address the Examiner's Response to Applicants' arguments below.

At page 14 of the Office Action, the Examiner argues that:

the motivation to apply the expandable material by extrusion, as claimed, comes from Ligon's teaching of a high precision and production rate, optionally in view of Bryant's teach of human error when sealant is applied

by workers. The fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

This argument by the Office Action lacks merit because it overemphasizes the stated motivations of precision and production rate where such motivations are not of particular importance. Specifically, precision of location is typically important for sealing applications such as the one discussed in Bryant since even a slight lack of precision can cause sealing failures. However, such precision is not as important in the method of vibration damping claimed in the present application. It is much more important to locate the expandable vibration material upon the door beam in a manner that allows the material to expand and reach the exterior door structure. Thus, Applicants contend that the precision motivation is based upon impermissible hindsight since it is a consideration for sealing but not a terribly significant consideration for the claimed method of vibration damping.

Further, there is no evidence on record that production rates for this particular application would be significantly increased using the system of Ligon et al. It should be understood that the production rate of the method of the present application is more likely to be governed by the rates at which the expandable material dries after extrusion or the ability to handle undried material or other factors. Moreover, as is further discussed below, any increase in production efficiency is pitted against other automation factors, which are further discussed below. Thus, Applicants contend that the production rate motivation is based upon impermissible hindsight since it is not a significant consideration for the claimed method of vibration damping.

Applicants further contend that the motivations of precision and production have been improperly used as a reason to ignore Applicants evidence of unexpected results. As discussed, the motivations provided by the Office Action lack merit. As such, no significant logical reasoning has been provided as to why the skilled artisan would combine Chrysler with the teachings of Ligon et al. to arrive at the subject matter of the claims of

the present application. Moreover, Applicants have discussed and further discuss reasoning that would lead the skilled artisan away from such a combination. In particular, automation, in the manner shown by Ligon et al., can involve significant effort in set up and execution. Such automation often requires the development of ways to move particular parts and an extruder relative to each other such that the part is properly located for application of material. Moreover, such development can require further investment of capital in systems needed to locate the part relative to the extruder and such systems can involve significant manual labor in operation. Thus, there are many reasons why the skilled artisan would be unlikely to modify Chrysler with the teachings of Ligon et al unless a clear motivation is provided in the prior art for doing so. In turn, these reasons suggest that the unexpectedly desired results discovered by Applicants in this case are particularly significant.

The Office Action also rebuffs Applicants argument, which, in essence, suggests that the prior art provides no evidence, which would lead the skilled artisan to believe that the extrusion of the expandable material directly onto the door beam would allow the expandable material to better jump the gap between the door beam and the exterior door structure. In particular, the Office Action, at page 15, reads that, "Accomplishing the required degree of expansion involves no more than extruding a sufficient amount of expandable material onto the door beam. Selection of sufficient material involves no more than routine experimentation ..." This suggestion by the Office Action lacks merit since it is speculation without support. More particularly, however, it lacks merit because additional material can be more difficult to locate upon the door beam such that simply using additional material may be prohibited. Moreover, such additional material can make the expandable material heavier such that it is more likely to droop during activation or come off the beam prior to expansion. Further, use of more material can be quite costly.

For all of these reasons, Applicants request that the rejections be withdrawn.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

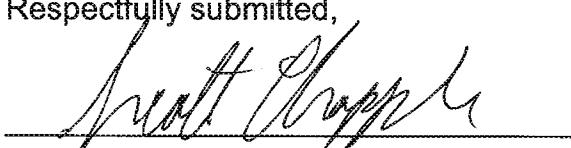
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Respectfully submitted,

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